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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sully's Living Without, Inc.

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Serial No. 75439790

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Keith M. Stolte of McDermott Will & Emery for Sully's  
Living Without, Inc.

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(David Shallant, Managing Attorney).

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Before Simms, Hohein and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 24, 1998, Sully's Living Without, Inc.  
(applicant) applied to register the mark BEWELLRED (typed)  
on the Principal Register for "men's, women's and  
children's clothing; namely shirts, sweatshirts, sweaters,  
pants, shorts, sweatpants, caps, hats, coats, jackets,  
stockings, underwear, robes, sweaters, leotards, leg  
warmers, tights, tank tops, panty hose, belts, rainwear,

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jogging suits, lounge wear, nightgowns, pajamas, nightshirts, wristbands[,] headbands, and swim suits" in International Class 25. Serial No. 75439790. The application was based on applicant's assertion of a bona fide intention to use the mark in commerce. The mark was published for opposition on December 1, 1998. After the mark was published for opposition, applicant filed a Statement of Use that contained a date of first use anywhere of March 1, 1999, and a date of first use in commerce of July 28, 1999. Applicant submitted one specimen, which is reproduced below.



The examining attorney then refused to register the mark on the ground that the mark as used on the goods is ornamental. Trademark Act Sections 1, 2 and 45. 15 U.S.C.

§§ 1051, 1052, and 1127. The examining attorney's position is that:

Prospective purchasers who view BEWELLRED on a t-shirt, when it is prominently emblazoned across the front of the shirt in large size standard form lettering, are not likely to consider it to be a trademark for shirts but rather are likely to perceive it the way they do other phrases prominently emblazoned across the fronts of shirts in large size standard form lettering - as a message, like LEGALIZE MARIJUANA, JUST SAY WHEN, or SWALLOW YOUR LEADER. In this case, the sentiment conveyed may be, Be well-read (well-read (wèl'rèd') adjective Knowledgeable through having read extensively.) or Be well, Red.<sup>1</sup>

Examining Attorney's Brief at 6.

In response, applicant maintains that there "can be no doubt that Applicant's BEWELLRED trademark is inherently distinctive. It is a coined word having no meaning, either in general or with respect to the shirts on which the mark appears." Applicant's Brief at 6.<sup>2</sup> Applicant then argues that in "accordance with the unambiguous statement in former Section 1202.04 and present Section 1202.03 of the TMEP that 'ornamental' matter that is inherently descriptive [sic, distinctive] serves as a source indicator

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<sup>1</sup> The examining attorney included this definition from *The American Heritage® Dictionary of the English Language* (3<sup>rd</sup> Ed. 1992) in her brief. We take judicial notice of this dictionary definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>2</sup> The examining attorney's argument that applicant's mark can mean "Be Well-Read" or "Be Well, Red" is a proper response to applicant's argument that its mark has no meaning.

and is thus registrable," applicant's mark is likewise registrable. Applicant's Brief at 7.

After the examining attorney made the refusal final, this appeal followed.

The mere fact that a term appears on a product does not necessarily make it a trademark. In re Pro-Line Corp., 28 USPQ2d 1141, 1142 (TTAB 1993). However, "[m]atter which serves as part of the aesthetic ornamentation of goods, such as T-shirts and hats, may nevertheless be registered as a trademark for such goods if it also serves a source-indicating function." In re Dimitri's Inc., 9 USPQ2d 1666, 1667 (TTAB 1988). "Where, as here, an alleged mark serves as part of the aesthetic ornamentation of the goods, the size, location, dominance and significance of the alleged mark as applied to the goods are all factors which figure prominently in the determination of whether it also serves as an indication of origin." Pro-Line, 28 USPQ2d at 1142.

In In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976) (emphasis in original, footnote omitted), the Court of Customs and Patent Appeals held:

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the

asserted mark has been used as a trademark with respect to the goods named in the application.

In this case, the specimen shows the term BEWELLRED prominently displayed in the upper center portion of the shirt. The mark is displayed on the front of the shirts in a manner that "immediately catches the eye." Pro-Line, 28 USPQ2d at 1142. The size, location, and dominance of applicant's mark on the shirt supports the conclusion that the mark would serve an ornamental rather than a source-identifying function on the goods.

In addition, the word(s) in the mark itself do not indicate that they would have anything other than an ornamental or informational significance. While the term BEWELLRED is not a recognized word in itself, it is easy to see that it consists of the words BE WELL RED (which is the phonetic equivalent of "read"). Applicant's specimens emphasize that it expects potential purchasers to see the term as three separate words because the words BE and RED are significantly darker than the center word WELL so that it creates an impression more like BEWellRED. The examining attorney's argument that the term would be understood by potential purchasers to mean "Be well-read" is logical and supported by applicant's use of the mark on its shirt.

Also, while applicant argues that its mark is inherently distinctive, non-descriptive phrases can be merely ornamental or informational. In re Olin Corp., 181 USPQ 182, 182 (TTAB 1973) ("It is a matter of common knowledge that T-shirts are 'ornamented' with various insignia, including college insignias, or 'ornamented' with various sayings such as 'Swallow Your Leader...' 'Swallow Your Leader' probably would not be considered as an indication of source"); Damn I'm Good Inc. v. Sakowitz, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) ("Damn I'm Good"). Applicant's term would appear to be an informational message or a slogan devoid of trademark significance. Pro-Line, 28 USPQ2d at 1142 (THE BLACKER THE COLLEGE THE SWEETER THE KNOWLEDGE).<sup>3</sup>

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<sup>3</sup> Applicant maintains that TMEP § 1202.03 supports the registrability of its mark because, applicant asserts, such section stands for the proposition that "'ornamental' matter that is inherently descriptive serves as a source indicator and is thus registrable." Applicant's Brief at 5. However, that section simply sets out that: "Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark." The section requires that subject matter that is inherently distinctive or that has acquired distinctiveness may be registered if it also serves as a source indicator and that it is only incidentally ornamental. As the case law above demonstrates, non-descriptive matter may properly be refused registration on the ground that the matter is ornamental.

In addition, there is no visible TM symbol on applicant's specimen.<sup>4</sup> This is some evidence that potential customers will not recognize applicant's mark as a trademark. In re Wakefern Food Corp., 222 USPQ 76, 78-79 (TTAB 1984) ("The fact that no symbol, such as 'TM' or 'SM,' is used to designate an alleged mark is also some evidence that the phrase is not being used in a trademark or service mark sense"). See also In re Astro-Gods Inc., 223 USPQ 621, 624 (TTAB 1984) (Use of copyright notice with ornamentation not enough to make an association between the designation and applicant's name).

We also observe that the record is devoid of any evidence that consumers recognize that applicant's mark has a source-identifying function or that it identifies a secondary source in addition to being ornamental. Our case law recognizes that the ornamentation of "a T-shirt can be of a special nature which ... inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name 'New York University' and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-Shirt will also advise the purchaser that the university is the secondary source of that shirt." In re Paramount Pictures

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<sup>4</sup> If there is a TM symbol, it is too small to be noticeable.

Corp., 213 USPQ 1111, 1112 (TTAB 1982). In that case, the Board found that the “*primary* significance of the words “MORK & MINDY” to any prospective purchasers of a decal such as the one here involved is to indicate the television series.” Id. (emphasis in original). The Board went on to discuss that arbitrary terms such as KODAK and DREFT have obvious source-indicating characteristics because they “usually have no other perceived significance.” Id. In this case, the record does not indicate that BEWELLRED would be recognized as an arbitrary term such as DREFT and KODAK or as an indicator of a secondary source such as MORK & MINDY and NEW YORK UNIVERSITY. As we indicated earlier, the mark itself is displayed in such a way that potential purchasers would recognize the term as the three words “Be Well Red (read).” Thus, applicant’s mark is more similar to the mark in Pro-Line and the example in Olin of ornamental subject matter.

In conclusion, it is our view that the term applicant seeks to register is primarily an ornamental feature of the goods and, therefore, it does not function as a trademark for the goods.<sup>5</sup>

Decision: The refusal to register is affirmed.

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<sup>5</sup> Applicant has not sought registration under the provisions of Section 2(f) of the Trademark Act.